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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,616	04/15/2004	Patrick W. Purcell	075205.0102	6323
24735	7590	08/20/2007	EXAMINER	
BAKER BOTTS LLP C/O INTELLECTUAL PROPERTY DEPARTMENT THE WARNER, SUITE 1300 1299 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004-2400			SMITH, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3637	
			NOTIFICATION DATE	DELIVERY MODE
			08/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/824,616	Applicant(s) PURCELL ET AL.	
	Examiner Matthew J. Smith	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12Aug04</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: lever 1015 [0045].

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8, 10, 14, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Cawley (3251629).

Cawley discloses an apparatus for removing surface coverings comprising a shaft 50 having a first end and a second end; a sleeve 46 slidably mounted on the first end of the shaft; a bracket 102 pivotably mounted on a first end of the sleeve; a drive mechanism 30 for shifting a rod 42 between a first rod position and a second rod position relative to the shaft; a blade 104 mounted on the bracket and extending away from the shaft; the bracket secured to the rod, such that as the rod moves between the first rod position and the second rod position; the bracket pivots on the sleeve and the sleeve slides on the shaft to shift a leading edge of the blade between a first edge position and a second edge position; means 60 for limiting the sliding of the sleeve on the shaft being a flange formed on the shaft, such that when the rod is in the first rod position, the sleeve distal end engages the flange; the sleeve extends beyond the first end of the shaft; the bracket pivotably mounted on the sleeve end extending beyond the sleeve first end; the drive mechanism mounted on the shaft; the rod retracted into the drive mechanism in the first rod position and the rod is extended from the drive mechanism in the second rod position; the drive mechanism shifts the rod from the first rod position to the second rod position; the blade leading edge raised from the first edge position to the second edge position; and the bracket has means 54 for traversing the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 15, 16, 23, 35-42, 49, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley in view of Sheperd (5906145).

Cawley discloses the invention substantially as claimed and a handle but not a drive mechanism having pins in oblong holes, switch, double-acting cylinder, or shield.

Sheperd shows an apparatus for removing surface coverings including means for limiting a rod 24 being a first pin 36 mounted on the shaft proximate to the first end and a first oblong hole 34 radially formed through the sleeve distal to the first end of the sleeve, such that the first oblong hole receives the first pin to restrict the sliding of the sleeve on the shaft to a length of the first oblong hole; a switch or trigger 92 for activating the drive mechanism to shift the rod between the first rod position and the second rod position; the switch is a two-position switch, such that when the switch is depressed, the rod shifts between the first rod position and the second rod position, and when the switch is released, the rod shifts between the second rod position and the first rod position; the switch located proximate to the drive mechanism; the shaft is hollow and the switch activator is disposed within the shaft to activate and deactivate the switch; an entry opening (Fig. 4) formed in the shaft; the drive mechanism is a double-acting cylinder 124; the drive mechanism shifts the rod from the retracted rod position to

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the extended rod position; the drive mechanism having a cylinder and a piston 124 and the rod affixed to the piston; the drive mechanism driven by compressed air; the switch located proximate to the drive mechanism; the blade edge 28 serrated; and the handle formed on the second end of the shaft.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to drive the blade with structure shown by Shepard in order to simplify the drive to disassemble (Sheperd, col. 3, lines 30-31).

While the combination does not disclose a second pin mounted on the shaft and a second oblong hole radially formed through the sleeve proximate to the sleeve first end, such that the second oblong hole receives the second pin to restrict the sliding of the sleeve on the shaft to the second oblong hole length, it would have been obvious to duplicate the pin and oblong hole since the structure and function would have been the same.

While the combination does not disclose a drive mechanism hydraulically driven, it would have been obvious to drive the device with hydraulic fluid since these air/hydraulic drives are considered functional equivalents.

Claims 9, 11-13, 17-22, 25-29, 32, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley in view of Amundson et al. (4663995).

Cawley discloses the invention substantially as claimed and a handle but not a double acting cylinder, piston, hydraulic drive, two supply lines, or the method.

Amundson et al. present an apparatus for removing surface coverings including double-acting cylinder 29 drive mechanism; a piston and a rod 27 affixed to the piston; the drive mechanism driven by compressed air; a first working fluid supply line 33 for delivering a first working fluid to a first working chamber of the double-acting cylinder, a second working fluid supply line 34 for delivering a second working fluid to a second working chamber of the double-acting cylinder; a switch 41 for alternating the delivery of the first working fluid to the first working chamber and the second working fluid to the second working chamber; a hollow shaft 22 (col. 3, line 23); the first working fluid is compressed air; the first working fluid is the same as the second working fluid; the blade edge 17 serrated; a handle formed on the shaft second end and perpendicular to the shaft; the handle includes the switch 41 for activating the drive mechanism to shift the rod between the first rod position and the second rod position; the switch is a two-position switch, such that when the switch is depressed, the rod shifts between the first rod position and the second rod position, and when the switch is released, the rod shifts between the second rod position and the first rod position; and a shield 90 extending from the sleeve toward a trailing edge of the blade.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to drive the blade with structure presented by Amundson et al. in order to remove shingles on a double sloping roof (col. 1, line 54).

It would have been further obvious to a person having ordinary skill in the art at the time the invention was made to remove surface coverings from a building using the combined apparatus, comprising the steps of: sliding the blade 104 along a building surface and forcing the blade underneath the surface covering; triggering the switch 41 for activating the drive mechanism to shift the rod between the first rod position and the second rod position; maintaining the apparatus against the building surface; and releasing the switch, so that the drive mechanism shifts the rod between the second rod position and the first rod position and adjusting an operating angle between the building surface and the shaft since the combined structure would have removed shingles in this manner.

While the combination does not disclose a drive mechanism hydraulically driven, it would have been obvious to drive the device with hydraulic fluid since these air/hydraulic drives are considered functional equivalents.

While the combination does not disclose the first working fluid supply line and the second working fluid supply line are disposed within the shaft or an entry opening formed in the shaft allowing the first working fluid supply line and the second working fluid supply line to enter the shaft and an exit opening formed in the shaft allowing the first working fluid supply line and the second working fluid supply line to exit the shaft, it would have been obvious to locate of the supply lines inside or outside the shaft since the function of the lines would not have been affected.

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Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley in view of Himebaugh (5218766).

Cawley discloses the invention substantially as claimed and a handle but not a roller mounted substantially perpendicular to the shaft to traverse a surface.

Himebaugh displays an apparatus for removing surface coverings including a means for traversing being a roller 20 mounted substantially perpendicular to the shaft.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a roller to traverse a surface, as displayed by Himebaugh, since roller and wheel are considered functional equivalents (Himebaugh, col. 2, lines 31-32).

Claims 24 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley in view of Sheperd as to claims 23 and 49, respectively, above, and further in view of Murray (5819603).

The combination discloses the invention substantially as claimed but not control cables.

Murray portrays an apparatus for removing surface coverings including a control cable inside a shaft and an exit opening formed in the shaft allowing the control cable to exit the shaft.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to place a control cable inside a shaft, as portrayed by Murray, in order protect the cable.

It would have been further obvious to a person having ordinary skill in the art at the time the invention was made to use two cables and place both cables inside a shaft to control two lines in order to increase efficiency.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley and Amundson et al. as applied to claim 25 above, and further in view of Martin (5863100).

The combination discloses the invention substantially as claimed but not an auxiliary handle.

Martin illustrates an apparatus for removing surface coverings including an auxiliary handle 72 positioned above the handle.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add an auxiliary handle, as illustrated by Martin, to the combined structure in order to improve handling.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley and Amundson et al and Martin as applied to claim 30 above, and further in view of Nicolosi et al. (6116117).

The combination discloses the invention substantially as claimed but not an auxiliary handle having a first arm portion of the auxiliary handle extending at an acute angle from the shaft toward the handle, a second arm portion extending from the first arm portion substantially perpendicular to the shaft, and a third arm portion extends substantially perpendicular to the second arm portion and toward the shaft.

Nicolosi et al. divulges an apparatus for removing surface coverings including an auxiliary handle 20 having a first arm portion of the auxiliary handle extending at an acute angle from the shaft toward the handle, a second arm portion extending from the first arm portion substantially perpendicular to the shaft, and a third arm portion extends substantially perpendicular to the second arm portion and toward the shaft.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add an auxiliary handle, as divulged by Nicolosi et al., to the combined structure in order to improve handling.

Claims 43-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley and Sheperd as applied to claim 36 above, and further in view of Amundson et al.

The combination discloses the invention substantially as claimed but not two supply lines.

Amundson et al. depict an apparatus for removing surface coverings including a first working fluid supply line 33 for delivering a first working fluid to a first working chamber of a double-acting cylinder 29, a second working fluid supply line 34 for delivering a second working fluid to a second working chamber of the double-acting cylinder, and a switch 41 for alternating the first working fluid delivery to the first working chamber and the second working fluid to the second working chamber; second working fluid is compressed air; and the first working fluid is the same as the second working fluid.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to drive the blade with structure presented by Amundson et al. in order to remove shingles on a double sloping roof (col. 1, line 54).

While the combination does not disclose the first working fluid supply line and the second working fluid supply line disposed within the shaft or an entry opening formed in the shaft allowing the first working fluid supply line and the second working fluid supply line to enter the shaft and an exit opening formed in the shaft allowing the first working fluid supply line and the second working fluid supply line to exit the shaft, it would have been obvious to locate of the supply lines inside or outside the shaft since the function of the lines would not have been affected.

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Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley and Sheperd as applied to claim 52 above, and further in view of Martin.

The combination discloses the invention substantially as claimed but not an auxiliary handle.

Martin illustrates an apparatus for removing surface coverings including an auxiliary handle 72 positioned above the handle.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add an auxiliary handle, as illustrated by Martin, to the combined structure in order to improve handling.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cawley and Sheperd as applied to claim 35 above, and further in view of Shirlin et al. (5001946).

The combination discloses the invention substantially as claimed but not a shield.

Shirlin et al. discuss an apparatus for removing surface coverings including a shield 90 extending from the sleeve toward a trailing edge of the blade.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a shield to the combined structure, as discussed by Shirlin et al., in order to protect the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 8-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lanna Mai
Supervisory Patent Examiner
Art Unit 3637



MJS *MJS*
13 August 2007